

REMARKS

Claims 1-41 are currently pending in the subject application and are presently under consideration. Claim 34 has been amended as shown on p. 7 of the Reply. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Finality of First Official Action

Initially, Applicants wish to gratefully acknowledge the Examiner's helpfulness on the telephone on multiple occasions respecting the finality of the present Official Action. Nonetheless, Applicants respectfully maintain that the finality of the present Official Action should be withdrawn. In this regard, MPEP Section 706.07(b) spells out when a final rejection can be proper on the first action, as follows:

706.07(b) - Final Rejection, When Proper on First Action

The claims of a new application may be finally rejected in the first Office action in those situations where (A) **the new application is a continuing application of, or a substitute for, an earlier application, and** (B) **all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.**

In this regard, some of the claims of the present application are properly the subject of a divisional application from parent application U.S. Appln. No. 09/528,078 (now U.S. Patent No. 6,708,164), as necessitated by a Restriction Requirement, dated 5-15-03, in the parent application. However, other independent claims, such as independent claim 13 of the present application, never appeared in the parent application.

Thus, Applicants respectfully submit that (A) is not met because the present application is a divisional application (a wholly different invention) necessitated by restriction requirement in the parent application, and thus not a continuing, or substitute, application for the earlier application and that (B) is not met because at least claim 13 of the present application is of different scope than any previous claim of the parent application (and therefore not *all* claims are the same claimed invention), and thus not directed to the same invention claimed in the earlier application. Since either reason alone prevents a first action final per MPEP 706.07(b), both

reasons independently suggest that the finality of the present Official Action is premature. Accordingly, reconsideration and withdrawal of the premature finality of this first Official Action in the present divisional application is respectfully requested.

II. Rejection of Claims 1-41 Under 35 U.S.C. § 101

Claims 1-41 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. With respect to the rejection under 35 U.S.C. § 101, Applicants respectfully submit that the test for statutory subject matter is not whether the claims explicitly recite “*a practical application*.” While it is agreed that the State Street standard for determining statutory subject matter under 35 U.S.C. § 101 requires subject matter that can be reduced to some “*practical application*,” and that the standard for this practical application has been, and remains, the production of “*a useful, concrete and tangible result*,” *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994), Applicants respectfully disagree with any further requirement requiring explicit identification of the practical application within the claim itself. Specifically, Applicants respectfully submit that the “*practical application*” need not be explicitly recited in a claim, but rather may be implicit in the structure or operation of the claimed elements when read in the context of the written description as a whole.

Notwithstanding, since Applicants believe the present invention possesses clear utility, to further advance the prosecution of the present application, Applicants set forth the clear statutory subject matter basis for a representative claim, as requested. For instance, with respect to claim 1, the useful, concrete and tangible result of the present invention is that mode information can be represented within a query itself that specifies a hierarchical data stream organization. A generated rowset is then processed based on the mode information of the query and a data stream is generated as a result that is organized according to the organization specified by the mode information. In this regard, never before could such mode information be specified within a query, and the number of practical applications for the present invention are considered practically limitless, i.e., wherever it is desirable to produce hierarchical data streams from rowset(s), the invention is of clear practical application.

A similar analysis is believed to apply to each of the other independent claims as well. In this regard, claim 34 has been amended herein to exclude “electrical signals” and thus each of claims 1-41 is believed to be tied to a computing system, a tangibly embodied computer

executable medium or various computerized methods of practicing the invention, and thus claims 1-41 are clearly not merely directed to an abstract idea. State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368 (Fed. Cir. 1998). Reconsideration and withdrawal of the rejection to claims 1-41 under 35 U.S.C. § 101 is thus respectfully requested.

III. Rejection of Claims 1-41 Under 35 U.S.C. § 102(e)

Claims 1-41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Cheng, et al. (US 6,366,934).

As mentioned above, the present divisional application was necessitated due to a Restriction Requirement, dated 5-15-03, in the parent application, now U.S. Patent No. 6,708,164. Upon review of the prosecution history of U.S. Patent No. 6,708,164, Applicants respectfully submit that the same distinguishing remarks apply to the present invention that applied in the parent application. Specifically, in Applicants' reply, dated 10-2-2003, just prior to allowance of the parent application, it was noted that Cheng et al. merely discloses a relational extender for a computer-implemented relational database system to help relational database users handle complex data types (Cheng et al., Col. 3, lines 35-37), but that **Cheng et al. fails to teach or suggest a method of producing query results wherein the organization of the query results is expressly requested within the query itself.** As is clear from the prosecution history, the parent application was allowed at least on this basis.

The present Official Action nonetheless refers to Col. 21, lines 7-9 for support that Cheng et al. discloses a query including mode information that specifies, within the query itself, a hierarchical data stream organization. The pseudo-code represented at Col. 21, lines 7-9, however, merely reads as follows:

```
SELECT xmlToBuff (book) from first_book
  WHERE name = 'Sriram Srinivasan'
  EXEC SQL OPEN c1;
```

However, nowhere does the above statement teach or suggest a query including mode information that specifies, *within the query itself*, a hierarchical data stream organization. The above statement is merely understood to specify a Select statement that operates only one way, and thus cannot be said to teach or suggest mode information, *within the query itself*, that specifies a hierarchical data stream organization.

For the same reasons, Applicants respectfully submit that Cheng et al. cannot be said to teach or suggest a query including mode information that specifies, within the query itself, a hierarchical data stream organization (claims 1, 9), a query including mode information that specifies, within the query itself, an extensible Markup Language (XML) data stream-organization (claim 11), a query specifying a mode for organizing information (claim 13), a query including mode information defining the XML data (claim 27), a query including mode information that specifies, within the query itself, an extensible Markup Language (XML) data stream organization by a primary-foreign key relationship (claim 28), a query having a number of tables included in the query that define the XML data stream (claim 32), a query in which the XML data stream has an organizational structure defined in the query (claim 34), a query in which the hierarchical data stream has an organizational structure defined in the query (claim 37), or a query including information for generating a universal table (claim 40), when read together with the other limitations of claims 1, 9, 11, 13, 27, 28, 32, 34, 37 or 40.

Reconsideration and withdrawal of the outstanding rejection under 35 U.S.C. § 102(e) is thus respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP1470USB].

Should the Examiner believe an additional telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,
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